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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : S. SCHRAGA

Confirmation No. 8544

Serial No : 10/641,142

Group Art Unit: 3731

Filed : August 15, 2003

Examiner: M. H. Thaler

For : ADJUSTABLE LANCET DEVICE AND METHOD

REPLY BRIEF UNDER 37 C.F.R. 41.41(a)(1)

Commissioner for Patents
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Sir:

This Reply Brief is in response to the Examiner's Answer dated September 5, 2006, the period for reply extending until November 6, 2006 (November 5, 2006 being a Sunday).

The Examiner maintains the grounds of rejection advanced in the final rejection of claims 1-3 and 8-44 and provides arguments in support thereof.

Appellant notes this Reply Brief is being filed under 37 C.F.R. 41.41(a)(1) and is directed to the arguments presented in the Examiner's Answer, and therefore must be entered unless the final rejection is withdrawn in response to the instant Reply Brief. With regard to this Reply Brief, Appellant notes it is addressing points made in the Examiner's Answer and not repeating the arguments set forth in the Appeal Brief.

POINTS OF ARGUMENT

First Issue

On the Pages 2-3, section 6, the Examiner indicates that the Section 112, 2nd paragraph, rejection is withdrawn. Appellant acknowledges that this rejection is withdrawn, that claims 1-3 and 8-42 are fully compliant with Section 112, 2nd paragraph, and hereby withdraws the arguments in the Appeal Brief regarding this rejection.

Second Issue

On the Pages 6 and 7, section 10 (*Response to Arguments*), the Examiner asserts that the body recited in the claims can be properly construed as member 20C (shown in Fig. 16 of SCHRAGA) and that the front cover recited in the claims can be properly interpreted as the combination of members 20A and 50. Appellant submits that this is an overly and improperly broad interpretation of SCHRAGA.

The lancet device disclosed in SCHRAGA simply does not utilize a two-piece front cover consisting of members 20A and 50. Member 50 of SCHRAGA is clearly shown as being a front cover and member 20/20A is clearly shown as being a body. The Examiner's characterization of these two members as the recited front cover is simply unreasonable and contrary to the express teachings of SCHRAGA. At the very least, the Examiner's interpretation is unsupported by the disclosure of SCHRAGA which clearly shows a front cover 50 and a body 20/20A.

The Examiner's interpretation is also improper because claim 1 recites that at least partial rotation of the front cover causes the skin engaging end to move axially

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relative to the second stop surface. The embodiment shown in Fig. 16 of SCHRAGA, on the other hand, functions by rotating member 20C relative to body 20A. There is simply no embodiment in SCHRAGA showing a front cover that can rotate, and, in fact, there is clear disclosure indicating that the front cover cannot (see Fig. 1 which shows a triangular shaped front cover). Thus, the only way that the Examiner can argue that this feature is disclosed in SCHRAGA is to invent a way of using the SCHRAGA device which was not contemplated in SCHRAGA and which is contrary to the disclosed way of using the device.

Finally, the Examiner's interpretation is improper because the Examiner has not been consistent in rejecting the claims over SCHRAGA. Assuming the Examiner could properly interpret the member 20C as the recited body of claim 1, then the rejection of claims 11, 15 and 16 would be clearly erroneous. Claim 11, for example, recites that the main spring is coupled to both the holding member and a surface of the body. However, it is clear from Fig. 16 that the main spring 40 is not coupled to the so-called body 20C, and is instead coupled to the actual body 20/20A. Furthermore, claim 15 recites that the trigger is movably mounted to the body. However, it is clear from Figs. 1, 2 and 16 that the trigger 45 is not mounted to the so-called body 20C, and is instead mounted to the actual body 20/20A. Finally, claim 16 recites that the front cover is removably mounted to the body. However, it is clear from Figs. 1 and 16 that the so-called front cover 50/20A is not removably mounted to the so-called body 20C. Instead, the front cover 50 is removably mounted to the actual body 20/20A.

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Third Issue

In section 10 (*Response to Arguments*), the Examiner neglects to set forth any response to Appellant's assertion that there is no proper basis for combining the teachings of the applied documents. In establishing a *prima facie* case of obviousness under 35 U.S.C. § 103, it is incumbent upon the Examiner to provide a reason *why* one of ordinary skill in the art would have found it obvious to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See *Ex parte Clapp*, 227 USPQ 972 (B.P.A.I. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from Applicant's disclosure. See, for example, *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). As noted above and in the Appeal Brief, each of the applied documents is silent with regard to a number of recited features and each of the documents relates to lancet devices which function in different manners. Moreover, none of the documents teaches or suggests modifying the structure or operation of either SCHRAGA and SLAMA in the manner asserted by the Examiner.

Because the art of record fails to provide any reasonable explanation why one ordinarily skilled in the art would utilize such an arrangement, and/or fails to disclose or suggest the problems that such an arrangement would address, Appellant submits that the art of record fails to provide the requisite motivation or rationale as to *why* one ordinarily skilled in the art would modify SLAMA to include

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features of SCHRAGA in the manner asserted by the Examiner. That is, Appellant submit that because the Examiner has not set forth any basis or reason found in the art of record for combining these documents, the instant rejection has no basis in the art of record, such that the rejection is improper and should be withdrawn.

Rejections based on 35 U.S.C. § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The Examiner has the initial duty of supplying the factual basis for the rejection and may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis. See *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967). As stated in *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984):

[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

Appellant submits that the only reason to combine the teachings of the applied references in the manner proposed by the Examiner is the result of a review of Appellant's disclosure and the application of impermissible hindsight.

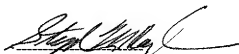
CONCLUSION

Accordingly, in view of the above-noted arguments (as well as those already

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of record), the Board is respectfully requested to reverse the Examiner's decision to finally reject claims 1-3 and 8-44 under 35 U.S.C. §§ 102(b) and 103(a), and that the application be remanded to the Examiner for withdrawal of the rejection over the applied documents and an early allowance of all claims on appeal.

Respectfully submitted,
S. SCHRAGA



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November 6, 2006
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